

AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P. O. Box 7599  
Loveland, Colorado 80537-0599

1631  
ATTORNEY DOCKET NO. 10980920-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jeffrey R. Sampson, et al.

Serial No.: 09/915,044

Examiner: 1631

Filing Date: July 24, 2001

Group Art Unit: Michael L. Borin

Title: METHODS FOR DETECTING A TARGET MOLECULE

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond  
☐ New fee as calculated below ☐ Supplemental Declaration  
☒ No additional fee (Address envelope to "Mail Stop Amendments")  
☐ Other: (Fee \$\_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 <sup>ST</sup> MONTH 120.00 <input type="checkbox"/>	2 <sup>ND</sup> MONTH 450.00 <input type="checkbox"/>	3 <sup>RD</sup> MONTH 1020.00 <input type="checkbox"/>	4 <sup>TH</sup> MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.2 5. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Jeffrey R. Sampson, et al.

By

Theodore J. Leitereg  
Theodore J. Leitereg  
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: July 20, 2005

Typed Name: Theodore J. Leitereg

Signature: Theodore J. Leitereg

Reg. No. 28,319

Date: July 20, 2005

Telephone No. 650-485-3864



**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on July 20, 2005.

Signature Theodore J. Leitereg Date 7/20/05

Name: Theodore J. Leitereg

PATENTS  
Attorney Docket No. 10980920-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Jeffrey R. Sampson, *et al.*

Serial No.: 09/915,044

Group Art Unit: 1631

Filed: July 24, 2001

Examiner: Michael L. Borin

Title: METHODS FOR DETECTING A TARGET MOLECULE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Response to Restriction Requirement**

This is responsive to the Restriction Requirement in the Office Action dated June 23, 2005, from the U.S. Patent and Trademark Office in the above-identified patent application.

**Restriction Requirement**

Restriction was required under 35 U.S.C. §121 to one of the following inventions:

Group I – Claims 1-4, 11, 12, 21, 62 and 63, drawn to a method of detecting a target molecule, classified in class 435, subclasses 6 and 7.1.

Group II – Claims 57-59, drawn to a method of testing a sample for the presence of nucleic acids, classified in class 435, subclass 6.

As required by the Restriction Requirement, Applicant elects the invention of Group I, Claims 1-4, 11, 12, 21, 62 and 63.

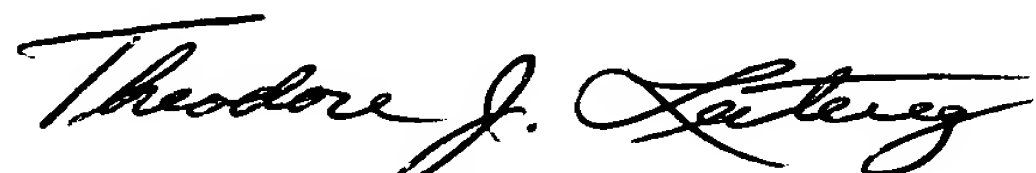
The Examiner stated that, because these inventions are distinct for the reasons set forth in the Office Action and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The Examiner indicated that the various inventions are patentably distinct. Accordingly, the Examiner has determined that the inventions of the various groups are separately patentable over one other. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, the restriction requirement necessarily involved the Examiner's determination at least implicitly that the inventions of the various groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be appropriate.

Furthermore, it follows from the above that art (if such art exists) indicating that the invention of one of the groups is known or would have been obvious would not extend to a holding that the invention of the other group is known or would have been obvious. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.

It is noted that Applicant's copy of the Office Action Summary indicated that Claims 1-4, 11, 12, 21, 57-59, 62 and 63 were rejected and did not indicate that these claims were subject to restriction and/or election requirement. Applicant has addressed the above restriction requirement, which is the only action set forth in the Detailed Action section of the Office Action.

Respectfully submitted,



Theodore J. Leitereg  
Attorney for Applicant  
Reg. No. 28,319

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